

REMARKS

This Amendment is submitted in response to the Office Action mailed on November 23, 2004. Claims 1, 2, 4, 6-15, 17-21, and 40-45 are pending. Claims 1, 11, 13, and 42 have been amended, claims 2 and 14 have been cancelled, and claims 46-49 have been added. In view of the foregoing amendments, as well as the following remarks, Applicant respectfully submits that this application is in complete condition for allowance and requests reconsideration of the application in this regard.

As an initial matter, Applicant noticed that the Examiner did not include an initialed copy of a Supplemental Information Disclosure Statement (IDS) filed electronically by the Applicant on August 31, 2004. Applicant requests that the Examiner provide an initialed copy of this electronic Supplemental IDS with the next written communication regarding this application.

Rejection of Claims Under 35 U.S.C. § 112

Claims 1, 2, 4, 6-15, 17-21, and 40-45 stand rejected under 35 U.S.C. § 112, second paragraph, as being broader than the enabling disclosure. Specifically, the Office Action contends that the specification lacks enablement for “overlap” or “in registry.” In the Office Action, the Examiner contends that:

Applicant’s specification is enabled to the extent that a mixture of sublimation dye and printing [ink] are applied at the same time. Neither of these materials “overlaps” or is “in registry with” the other since both the sublimation dye and printing ink occupy the same space in the same plane. The specification does not enable the situation where one of the colorants overlaps or is in registry with the other colorant. Both of the terms “overlap” and “registry” imply covering or super-imposition.

Applicant respectfully disagrees with these contentions and requests that this rejection be withdrawn.

Under prevailing Federal Circuit case law, the test for determining compliance with the enablement requirement is that a patent specification should "teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" Genentech Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365 (Fed. Cir. 1997); In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988); United States v. Teletronics, Inc., 857 F.2d 778, 785 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent specification need not teach, and preferably omits, what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed.Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert.denied*, 480 U.S. 947 (1987); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463 (Fed. Cir. 1984); In re Howarth, 654 F.2d 103, 105 (CCPA 1981) ("An inventor need not, however, explain every detail since he is speaking to those skilled in the art."). The Federal Circuit has noted that "[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774 (CCPA 1962).

Applicant respectfully submits that the art of printing is highly predictable and that the amount of direction or guidance needed in Applicant's specification, as filed, to meet the enablement requirement would have been relatively meager because of this high degree of predictability. Applicant states at page 6, lines 14-16 of the specification that "[t]he image is *typically* printed on a visible panel of the product package using a blend of printing inks and

sublimation dyes.” (Emphasis added). It follows that Applicant’s specification is not limited to the situation in which “a mixture of sublimation dye and printing [ink] are applied at the same time,” as suggested in the Office Action. This construction constitutes merely one specific embodiment of Applicant’s invention in which a printing ink and sublimation dye are blended and then printed simultaneously onto the package panel.

Moreover, Applicant’s specification does not require the sublimation dye and printing ink to “occupy the same space.” Applicant states at page 8, lines 18-21 of the specification that “[t]he printed image 10 is a composite of two *overlapping* and interlaced components - a transferrable image component and a visible image component - that are reverse printed onto the panel 11 or other portion of the package 14.” (Emphasis added). Applicant states at page 9, lines 1-5 of the specification that “[i]n certain embodiments of the invention, the visible image component of the printed image 10 may have features not present in the transferrable image component and, conversely, the transferrable image component of the printed image 10 may have features absent from the visible image component.” Reading these two statements conjunctively, it is apparent that the Applicant did not intend for the term “overlapping” to limit the visible and transferrable images to occupy the same space, as suggested in the Office Action. If the printing ink and sublimation dye were required to be blended together and printed onto the panel, it would be impossible for the visible and transferrable images to have different features.

Applicant states at page 8, lines 23-24 of the specification that “[f]eatures of the transferrable image component are *typically* registered with the features of the visible image component.” (Emphasis added). Applicant’s specification does not require registration of the overlapping visible and transferrable images, but instead permits this situation. A person of

ordinary skill in the art of printing would recognize that the ordinary and customary meaning of the term “registration” is “the fitting of two or more printing images in exact alignment with each other.” See Pocket Pal: A Graphic Arts Production Handbook, International Paper Company, Nineteenth Edition, p. 232 (August 2003). International Paper touts the Pocket Pal in the Foreward to the booklet as the “authoritative introduction to the graphic arts.” This handbook has been in print and relied upon in the printing industry since 1934. Relevant and selected portions of the handbook are enclosed as Exhibit A, which is attached as an Appendix to this Amendment. These relevant and selected portions are also being submitted in a Supplemental IDS filed on even date herewith.

One approach for producing registration would be to blend the printing ink and sublimation dye and then print the blended mixture onto the panel. As the Office Action suggests, this situation suggests “covering or super-imposition” and is enabled by Applicant’s specification. However, Applicant’s use of the term “registration” would also extend to other processes understood by a person of ordinary skill in the art of printing that would produce registration, as authoritatively established by Exhibit A. For example, the printing ink may be printed by a first process in a printing device and the sublimation dye may be printed by a separate process in a printing device such that the images are registered but without blending the printing ink and sublimation dye together.

Accordingly, based upon the preceding remarks, Applicant respectfully requests that the rejection of claims 1, 2, 4, 6-15, 17-21, and 40-45 be withdrawn.

Rejections of Claims Under 35 U.S.C. § 103

Claims 1, 4, 9, 11-13, 15, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,308,679 (Ray et al.) in view of U.S. Patent No. 6,174,400 (Krutak et al.). Applicant has amended the rejected independent claims 1 and 13 to include the subject matter set forth in dependent claims 2 and 14, respectively. The Office Action did not reject these original dependent claims as obvious over *Ray et al.* in view of *Krutak et al.* Consequently, Applicant respectfully requests that this rejection be withdrawn.

Independent claims 1 and 13 are patentable for at least an additional reason. Applicant submits that the Office Action has failed to provide a proper suggestion or motivation to combine *Krutak et al.* with *Ray et al.* The Office Action suggests that these references would have been obvious to combine because the *Krutak et al.* image has an advantage of being a “security feature.” However, this purported motivation would seem to have little meaning as a rationale for modifying *Ray et al.* in the manner suggested by the Examiner. Specifically, promotional items as disclosed in *Ray et al.* would not require a security feature as would be produced by using the transfer ribbon disclosed in *Krutak et al.* to print the heat transferable image of *Ray et al.* Hence, a person of ordinary skill in the art would not be motivated to make the suggested combination based upon the presence of a security feature. Because the Office Action fails to support a *prima facie* case of obviousness, Applicant requests that this rejection be withdrawn.

New Claims

Applicant has elected to present claims 48 and 49 as new independent claims that are patentable for at least the same reasons as independent claims 1 and 13. New claims 46 and

47 each depend from a patentable independent claim. Furthermore, these claims recite unique combinations of elements not taught, disclosed or suggested by either *Ray et al.* or *Krutak et al.*

Conclusion

Applicant has made a bona fide effort to respond to each and every requirement set forth in the Office Action. In view of the foregoing amendments and remarks, this application is submitted to be in complete condition for allowance and, accordingly, a timely notice of allowance to this effect is earnestly solicited. In the event that any issues remain outstanding, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicant does not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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